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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,633	09/25/2003	Patrick Michel White	1.P566.35	6854

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EXAMINER

COMSTOCK, DAVID C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,633

Applicant(s)

WHITE, PATRICK MICHEL

Examiner

David Comstock

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 30 October 2003.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because Figures 3-5 should be designated by a legend such as --Prior Art-- (as they were in the previously filed informal drawings) because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

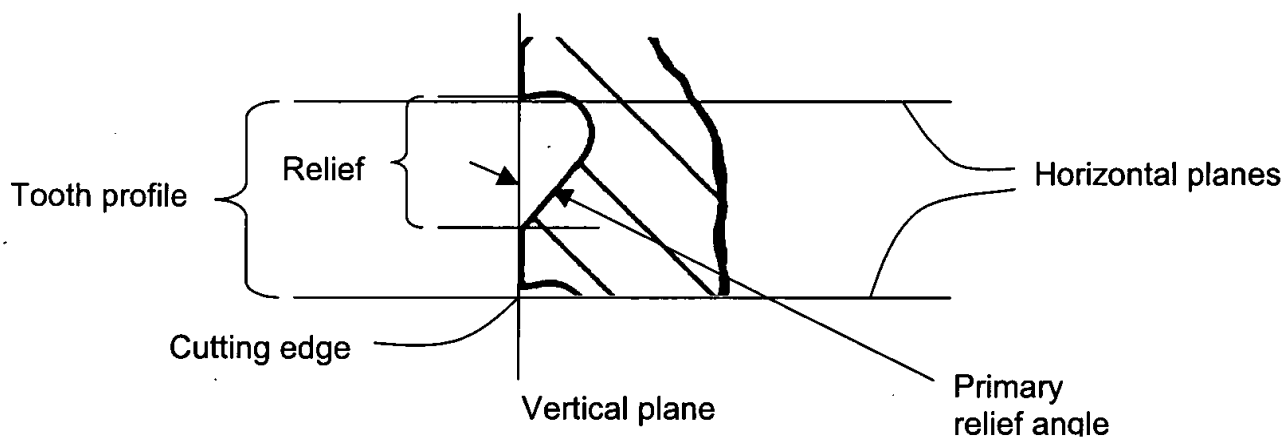
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasilewski (5,041,118; cited by Applicant).

Wasilewski discloses an elongated cutting tool 10 that can be characterized as a broach, or a rasp, i.e. a tool with sharp edges for abrading and removing material (see Fig. 1). The tool includes a plurality of teeth 24,26 arranged in a generally diamond shape thereabout. This diamond shape is oriented at an angle to a drive axis, e.g., a vertical axis. The tool includes chip breakers, i.e., the cutout or void regions defined between the teeth 24,26 (see Fig. 1 and col. 4, lines 3-6). In addition, the tool includes

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chip breakers 30 at a distal end of the tool (see Fig. 3 and col. 4, lines 20, 21). The teeth 24 are undercut teeth having a cutting edge and a profile defined substantially along a primary relief angle and a positive rake angle **A** (see Fig. 10 and Diagram 1, below). The primary relief angle is measured from a vertical plane passing through the cutting edge. The positive rake angle is measured from a horizontal reference plane passing through the cutting edge. The teeth define a relief that is parabolic--i.e., of, relating to, or resembling a parabola--and non-circular--i.e., not a closed, circuitous loop of constant curvature--at least within a broadest reasonable interpretation, since the relief resembles a parabola and, in fact, much more closely so than a circle or circular shape. The tool includes a handle attachment interface 36. It is noted that the presence of the vertical surface portion 32 (see Fig. 10 and col. 4, lines 35-50) does not preclude anticipation since the present claims read on the invention disclosed by Wasilewski, as set forth herein.

**Diagram 1**

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski (5,041,118; cited by Applicant) in view of Szabo (5,681,315).

Wasilewski discloses the claimed invention except for the helical tooth pattern. Szabo disclose a similar device having helically wound teeth 22,28 in order to lift off bone material effectively and reduce the pathological effect on the patient (see Figs. 5-9; col. 1, line 66 - col. 2, line 1; and col. 5, line 39 - col. 6, line 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cutting tool of Wasilewski with helically arranged teeth, in view of Szabo, in order to lift off bone material effectively and reduce the pathological effect on the patient. With regard to claim 6, it would have been further obvious to provide teeth within a range of progressively increasing sizes or within any of numerous other ranges of size, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Moreover, determining the appropriate size of the components of an invention is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock
26 October 2004



EDUARDO C. ROBERT
PRIMARY EXAMINER